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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,499	08/01/2001	Kenzo Sekiguchi	2922.0045	3225

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EXAMINER	
HUNTSINGER, PETER K	
ART UNIT	**PAPER NUMBER**
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/918,499	SEKIGUCHI, KENZO	
	Examiner	Art Unit	
	Peter K. Huntsinger	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *22 February 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-23 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 23 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 23 is directed to a program stored in a computer-readable medium. For claim 23 to be statutory, the applicant must state "A computer-readable medium storing a computer program" (or equivalent) not a program comprising a computer-readable medium.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 2, 4-6, 9-13, 15-17 and 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik '286 and Shibata '955.

Referring to claim 1, Malik '286 discloses a communication apparatus comprising: connecting means for connecting the communication apparatus to a communication network containing an electronic mail exchange device (Network 13 of Fig. 1, col. 3-4, lines 54-67, 1-6); input means for inputting image data representing an image; transmitting means for transmitting an electronic mail, to which the image data inputted by said input means is attached, via said connecting means (col. 5, lines 8-19); receiving means for receiving an electronic mail for notifying an error via said connecting means; analyzing means for analyzing the electronic mail for notifying the error received by said receiving means; converting means for converting a capacity of the image data, inputted by said input means, into a smaller capacity according to an analysis result obtained by said analyzing means; and control means for carrying out a controlling operation so as to retransmit the electronic mail, to which the image data with the capacity thereof converted by said converting means is attached, by said transmitting means (col. 7-8, lines 60-67, 1-17). Malik '286 does not disclose expressly outputting a report after transmitting an electronic mail. Shibata '955 discloses output means for outputting a report including at least a transmitting data (transmission date 61 of Fig. 8); a destination (destination 63 of Fig. 8) and information for specifying a conversion method used by said converting means in a case where a retransmitting of the electronic mail by said transmitting means has been carried out (col. 12, lines 40-52). The report shows multiple transmissions that have been made. A single email that is divided into multiple emails as disclosed by Malik '286 would appear as multiple transmissions on the report of Shibata '955. At the time of the invention, it would have

obvious to a person of ordinary skill in the art to output a report after transmission of an email. The motivation for doing so would have been to notify the user of the status of the email. Therefore, it would have been obvious to combine Shibata '955 with Malik '286 to obtain the invention as specified in claim 1.

Referring to claim 2, Malik '286 discloses wherein said converting means converts the capacity of image data specified by the electronic mail analyzed by said analyzing means (col. 5, lines 8-19).

Referring to claim 4, Malik '286 discloses wherein said converting means reduces the capacity by reducing a size of an image represented by the image data inputted by said input means (col. 5, lines 8-19).

Referring to claim 5, Malik '286 discloses wherein said converting means reduces the capacity per electronic mail by dividing the image data inputted by said input means into a plurality of pieces (col. 8, lines 42-55).

Referring to claim 6, Malik '286 discloses wherein said converting means reduces the capacity by raising a compression rate of the image data inputted by said input means (col. 5, lines 8-19).

Referring to claim 9, Malik '286 discloses setting means for setting for said converting means one of a plurality of conversion methods to be used; and wherein said converting means converts the capacity by the conversion method set by said setting means (col. 8, lines 29-55).

Referring to claim 10, Malik '286 discloses wherein said converting means converts the capacity by using a combination of a plurality of converting methods (col. 8, lines 29-55).

Referring to claim 11, Malik '286 discloses wherein: said control means repeats the conversion by said converting means and the retransmission by said transmission means every time said receiving means receives an electronic mail for notifying an error (col. 7-8, lines 60-67, 1-17).

Referring to claim 12, see the rejection of claim 1 above.

Referring to claim 13, see the rejection of claim 2 above.

Referring to claim 15, see the rejection of claim 4 above.

Referring to claim 16, see the rejection of claim 5 above.

Referring to claim 17, see the rejection of claim 6 above.

Referring to claim 20, see the rejection of claim 9 above.

Referring to claim 21, see the rejection of claim 10 above.

Referring to claim 22, see the rejection of claim 11 above.

Referring to claim 23, see the rejection of claim 1 above.

6. Claim 3, 8, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik '286 and Shibata '955 as applied to claims 1 and 12 above, and further in view of Kodaira '183.

Referring to claims 3 and 14, Malik '286 discloses reducing the size of an image and utilizing file specific compression types, but does not disclose expressly lowering a

resolution of an image. Kodaira '183 discloses wherein a converting means reduces the capacity by lowering a resolution of an image represented by image data inputted by input means (col. 24, lines 31-44). At the time of the invention, it would have been obvious to one of ordinary skill in the art to lower the resolution of an image in the system of Malik '286. The motivation for doing so would have been to reduce the size of the image file using a known image compression technique. Further, the commonly used image compression format JPEG compresses image data by lowering the resolution of an image. Therefore, it would have been obvious to combine Kodaira '183 with Malik '286 and Shibata '955 to obtain the invention as in claims 3 and 14.

Referring to claims 8 and 19, Malik '286 discloses reducing the size of an image and utilizing file specific compression types, but does not disclose expressly converting multivalued image data into binary image data. Kodaira '183 discloses wherein said converting means reduces the capacity by converting the image data which is multivalued image data, inputted by said input means, into binary image data (col. 24, lines 31-44). At the time of the invention, it would have been obvious to one of ordinary skill in the art to convert mulivalued image data into binary image data. The motivation for doing so would have been to reduce the size of the image file using a known image compression technique. Therefore, it would have been obvious to combine Kodaira '183 with Malik '286 and Shibata '955 to obtain the invention as in claims 8 and 19.

7. Claims 7 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Malik '286 and Shibata '955 as applied to claims 1 and 12 above, and further in view of Knowlton '389.

Referring to claims 7 and 18, Malik '286 discloses reducing the data size of an image by compressing the data but does not disclose converting color image data into black and white image data. Knowlton '389 discloses wherein converting means reduces the capacity by converting image data which is color image data, inputted by input means, into black-and-white image data (col. 3, lines 4-13). At the time of the invention, it would have been obvious to one of ordinary skill in the art to convert color data into black and white data in the system of Malik '286. The motivation for doing so would have been to reduce the size of an image. Therefore, it would have been obvious to combine Knowlton '389 with Malik '286 and Shibata '955 to obtain the invention as in claims 7 and 18.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter K. Huntsinger whose telephone number is (571)272-7435. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Moe Aung can be reached on (571)272-7314. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PKH

AUNG S. MOE
SUPERVISORY PATENT EXAMINER
5/16/07